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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/826,786

Filing Date: April 05, 2001

Appellant(s): MONTOYA, PATRICK

John G. Posa
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 9/11/08 appealing from the Office action mailed 4/11/08.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

No amendment after final has been filed.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

WITHDRAWN REJECTIONS

The following grounds of rejection are not presented for review on appeal because they have been withdrawn by the examiner. Previous rejection under 35 USC 112, 1st paragraph withdrawn.

NEW GROUND(S) OF REJECTION

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-7, 9, 10, 15, 16, 31 are rejected under 35 U.S.C. 101. Based on Supreme Court precedent and recent Federal Circuit decisions, the Office's guidance to examiners is that a § 101 process must (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. Diamond v. Diehr, 450 U.S. 175, 184 (1981); Parker v. Flook, 437 U.S. 584, 588 n.9 (1978); Gottschalk v. Benson, 409 U.S. 63, 70 (1972); Cochrane v. Deener, 94 U.S. 780, 787-88 (1876).

An example of a method claim that would not qualify as a statutory process would be a claim that recited purely mental steps. Thus, to qualify as a § 101 statutory process, the claim should positively recite the other statutory class (the thing or product) to which it is tied, for example by identifying the apparatus that accomplishes the method steps, or positively recite the subject matter that is being transformed, for example by identifying the material that is being changed to a different state.

Here, applicant's method steps fail the first prong of the new Federal Circuit decision since they are not tied to another statutory class and can be performed without the use of a particular apparatus. Thus, claims 1-7, 9, 10, 15, 16, 31 are non-statutory since they may be performed within the human mind.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

6,175,833	West et al	1-2001
6,330,608	Stiles	12-2001

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 1-3, 5, 9, 10, 15, and 16 rejected under 35 U.S.C. 102(e) as being anticipated by West et al et al, US 6,175,833.

As per claim 1, West et al teaches establishing communication between a client and a survey collector having previously collected survey results, the results including a composite survey response (column 3, lines 38-63 – computer network system; column 4, lines 16-27 – online voting; inherently the system contains voting results for all surveys); receiving by the survey collector a request from the client for the previously collected survey results (column 9, lines 19-36 – user requests story along with survey results); providing the client with a survey

questionnaire from the survey collector (column 7, line 54 – column 8 line 67 – user is presented a survey if the user has not already submitted a vote); providing access to the previously collected survey results to the client only if the survey collector receives a response to the survey questionnaire from the client (column 9, lines 19-36 – user must first vote before viewing survey results); rejecting the client's request for the survey results if a response to the survey questionnaire is not received from the client (column 9, lines 19-36 – inherently if the user does not vote, he/she does not gain access to the survey results); and wherein the composite survey response is unrelated to the survey questionnaire (column 3, lines 38-63 – computer network system; column 4, lines 16-27 – online voting; inherently the system contains voting results for all surveys)

As per claim 2, West et al teaches establishing communication is done via the Internet (column 3, lines 38-63 – computer network system; column 4, lines 16-27 – online voting).

As per claim 3, West et al teaches relating the survey questionnaire by subject matter to the previously collected survey results (column 8, lines 41-65 – survey ID used to correlate with user's global unique identifier (GUID)).

As per claim 5, West et al teaches providing the client with the survey questionnaire includes requesting the identifying indicia from the client (column 8, lines 41-65 – survey ID used to correlate with user's global unique identifier (GUID)).

As per claim 9, West et al teaches receiving by the survey collector identifying indicia from the client (column 5, lines 47-50 and column 6, lines 28-38 – obtains user's global unique identifier; column 8, lines 41-65 – survey ID used to correlate with user's global unique

identifier (GUID)); and correlating the identifying indicia with a database to determine if a relationship exists between the identifying indicia and the subject matter of the survey questionnaire (column 5, lines 47-50 and column 6, lines 28-38 – obtains user's global unique identifier; column 8, lines 41-65 – survey ID used to correlate with user's global unique identifier (GUID)).

As per claim 10, Matyas teaches receiving by the survey collector identifying indicia from the client (column 5, lines 47-50 and column 6, lines 28-38 – obtains user's global unique identifier); and correlating the identifying indicia with a database to determine determining if a relationship exists between the identifying indicia and the client (column 5, lines 47-50 and column 6, lines 28-48 – obtains user's global unique identifier determines whether user has voted previously).

As per claim 15, West et al teaches the client is denied access to the previously collected survey results if no relationship is found between the indicia and the client (column 9, lines 19-36 – inherently if the user does not vote, he/she does not gain access to the survey results).

As per claim 16, West et al teaches assimilating the survey response into a composite survey response (column 3, lines 38-63 – computer network system; column 4, lines 16-27 – online voting; inherently the system contains voting results for all surveys).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 4, 6 and 7 rejected under 35 U.S.C. 103(a) as being unpatentable over West et al, US 6,175,833.

As per claim 4, West et al teaches the creation of surveys (column 5, lines 1-22) but does not explicitly teach the request for previously collected survey results and the survey questionnaire are related to automotive vehicles; however, these differences are only found in the non-functional descriptive material and are not functionally involved in the steps recited nor do they alter the recited structural elements. The recited method steps would be performed the same regardless of the specific data. Further, the structural elements remain the same regardless of the specific data. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, *see In re Gulack, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); In re Lowry, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994); MPEP § 2106.*

As per claim 6, West et al teaches identifying indicia (column 5, lines 47-50 and column 6, lines 28-38 – obtains user's global unique identifier), but does not explicitly teach the indicia is a product identification number; however, these differences are only found in the non-functional descriptive material and are not functionally involved in the steps recited nor do they alter the recited structural elements. The recited method steps would be performed the same regardless of the specific data. Further, the structural elements remain the same regardless of the specific data. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, *see In re Gulack, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); In re Lowry, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994); MPEP § 2106.*

As per claim 7, West et al teaches identifying indicia (column 5, lines 47-50 and column 6, lines 28-38 – obtains user's global unique identifier), but does not explicitly teach the indicia is a VIN number; however, these differences are only found in the non-functional descriptive material and are not functionally involved in the steps recited nor do they alter the recited structural elements. The recited method steps would be performed the same regardless of the specific data. Further, the structural elements remain the same regardless of the specific data. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, *see In re Gulack, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); In re Lowry, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994); MPEP § 2106.*

Claim 31 rejected under 35 U.S.C. 103(a) as being unpatentable over West et al, US 6,175,833, further in view of Stiles, US 6,330,608.

As per claim 31, West et al teaches receiving by the survey collector identifying indicia from the client and only providing survey results if the user's global unique identifier is correlated and shows the user has previously voted (column 5, lines 47-50 and column 6, lines 28-48 – obtains user's global unique identifier), but does not explicitly teach correlating the identifying indicia with a database to determine if the client is a registered member and providing access only if the client is also a registered member. Stiles teaches a method and system for registering modules or service providers requesting access to a computer system, its hardware and/or its software wherein only registered modules will access to the computer system. It would have been obvious to one of ordinary skill in the art at the time of the invention to include in the survey system of West et al the registration function as taught by Stiles since the claimed invention is merely a combination of old elements, and in combination each element

merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized the results of the combination were predictable.

(10) Response to Argument

Previous rejections under 35 USC 112, 1st paragraph withdrawn.

Appellant first argues that West et al does not teach establishing communication between a client and a survey collector having previously collected survey results. Examiner states that West et al teaches a computer network system (column 3, lines 38-63) wherein online voting takes place (column 4, lines 16-27). West et al discusses tallying total votes cast and updating a database with the voting results (column 5, lines 47-67, column 8 and column 9). Inherently the system contains voting results for all surveys.

Regarding Appellant's arguments that West et al fails to teach providing access to previously collected survey results only if the survey collector receives a response to the survey questionnaire from the client, Appellant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references. Appellant simply points to cited portions of West et al without any analysis of how the claim language distinguishes from the reference.

Appellant further argues that West et al does not teach rejecting the client's request for the survey results if a response to the survey questionnaire is not received from the client. Examiner points to West et al (column 9, lines 19-36), wherein a user must first vote before viewing survey results. Examiner asserts that if the user has not voted, the request to view results is rejected, since the only way to view results is to cast a vote.

Finally, Appellant argues West et al does not teach wherein the composite survey response is unrelated to the survey questionnaire. Examiner would like to point out that inherently West et al teaches composite survey responses that are unrelated to the survey questionnaire. The system is set up for users to define survey questions wherein the results are tallied and stored (column 9, lines 62-67). Therefore, the system stores several, possibly hundreds, of survey questions and responses, all of which may or may not be related. As claimed, the results happen to include these composite survey responses that are not related to the survey questionnaire, but the composite survey responses have no bearing on any analysis done by the claim.

In response to Appellants arguments regarding Examiners rejection of claim 31, Examiner would like to point to the Supreme Court Decision in KSR International Co. v. Teleflex Inc., hereinafter, KSR. KSR forecloses Appellant's argument that a specific teaching is required for a finding of obviousness. KSR, 127 S.Ct. at 1741, 82 USPQ 2d at 1396. Since each of the elements of the cited references combined performs the same function when combined as it does in the prior art, such a combination would have yielded predictable results. See Sakraida, 425 U.S. at 282, 189 USPQ at 453.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

This examiner's answer contains a new ground of rejection set forth in section **(9)** above. Accordingly, appellant must within **TWO MONTHS** from the date of this answer exercise one

of the following two options to avoid *sua sponte* **dismissal of the appeal** as to the claims subject to the new ground of rejection:

(1) **Reopen prosecution.** Request that prosecution be reopened before the primary examiner by filing a reply under 37 CFR 1.111 with or without amendment, affidavit or other evidence. Any amendment, affidavit or other evidence must be relevant to the new grounds of rejection. A request that complies with 37 CFR 41.39(b)(1) will be entered and considered. Any request that prosecution be reopened will be treated as a request to withdraw the appeal.

(2) **Maintain appeal.** Request that the appeal be maintained by filing a reply brief as set forth in 37 CFR 41.41. Such a reply brief must address each new ground of rejection as set forth in 37 CFR 41.37(c)(1)(vii) and should be in compliance with the other requirements of 37 CFR 41.37(c). If a reply brief filed pursuant to 37 CFR 41.39(b)(2) is accompanied by any amendment, affidavit or other evidence, it shall be treated as a request that prosecution be reopened before the primary examiner under 37 CFR 41.39(b)(1).

Extensions of time under 37 CFR 1.136(a) are not applicable to the TWO MONTH time period set forth above. See 37 CFR 1.136(b) for extensions of time to reply for patent applications and 37 CFR 1.550(c) for extensions of time to reply for ex parte reexamination proceedings.

Respectfully submitted,

/Johnna Loftis/

9/29/08

/Beth V. Boswell/

Supervisory Patent Examiner, Art Unit 3623

Vincent Millin/VM/

Appeals Practice Specialist- TC 3600

A Technology Center Director or designee must personally approve the new ground(s) of rejection set forth in section (9) above by signing below:

/Wynn W. Coggins/

Director, TC 3600

Conferees:

Beth V. Boswell /bvb/

Supervisory Patent Examiner, AU 3623

Vincent Millin

Appeals Conference Specialist, TC 3600